

REMARKS

Claims 1, 4, 6-11, 14 and 16-22 are pending in the application.

Claims 1, 4, 6-11, 14 and 16-22 are rejected. No claims have been amended.

Reconsideration and allowance of claims 1, 4, 6-11, 14 and 16-22 is respectfully requested in view of the following:

Responses to Rejections to Claims – 35 U.S.C. §103

Claims 1, 4, 6-11, 14 and 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sleeman (U.S. Publication No. 2004/0260843) (Sleeman) in view of Saunders (Newcard Exposed) (Saunders), and further in view of Fischer et al (U.S. Patent No. 6,936,936) (Fischer). Claims 9-10 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sleeman as applied to claim Saunders above, and further in view of Cheng et al (U.S. Patent No. 6,935,130) (Cheng). Applicants respectfully disagree.

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons:

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in any combination, do not teach power means including (1) a power adapter connected to provide power to the second subsystem including the user console, whereby the power adapter is operable to receive an AC power input to be converted to various voltages as required by the user console, and (2) the second subsystem deriving power from the computer via a powerline of the Newcard device.

The Examiner asserts that Fischer provides for a power adapter to convert AC voltage to a plurality of voltages required by different components of the computer system. Final Office

action dated November 5, 2008 at pg. 13. Even assuming this to be true, arguendo, this does not provide for the second subsystem receiving power from two places: (1) a power adapter and (2) from the computer via a powerline of the Newcard device as claimed.

The Examiner states in response to Applicants previous arguments that:

"The NewCard, also known as ExpressCard, by definition, consists of two I/O buses (PCI-Express and USB), and power is supplied to the card by the host system via the PCI-Express and USB power interface/pins. Specifically, the Newcard draws 3.3 volts from the host via power interface of the PCI-E and/or USB power interface. For example, in case of USB power interface, a voltage supply is provided in a wire or "line" as dictated by the USB specification. Thus, it is clear that power is derived from the computer system via a power line or wire of the NewCard consisting of two I/O buses, namely PCI-E bus and the USB bus."

Office action dated November 5, 2008 at pg. 14 and 15.

Even adopting, arguendo, the Examiner's position that a NewCard includes an industry standard bus (e.g., USB), that bus includes a wire that carries a voltage (e.g., 3.3V), and that that bus draws the power from a host, all the claim elements have not been properly considered. Specifically, the claim requires a second component of the power means where the second subsystem derives power from the computer via a powerline of the Newcard device. A second subsystem deriving power from a computer via a powerline of a card is clearly different than a disclosure that provides merely a voltage on a wire in a bus of the card. The Examiner admits that the disclosure provides "power is supplied to the card by the host system." Providing power to a card from a host also does not disclose providing power from a first subsystem to a second subsystem via a powerline of a card as claimed.

Applicants also note that Fig. 2 of Sleeman relied on by the Examiner, illustrates a card bus connecting to a host computer, but does not illustrate such a bus connected to a second subsystem. Therefore, even under the Examiner's asserted configuration, it is not feasible for power to be supplied from the host to a second system via the bus, as the bus is not even connected to both a first (or host) and a second subsystem (see e.g., port 38 of Fig. 2, port 68 of Fig. 3). Furthermore, Sleeman discloses the I/O connection (port 38 of Fig. 2, port 68 of Fig. 3) provides a modem connection which provides no indication of providing power. Sleeman at [0028].

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima*

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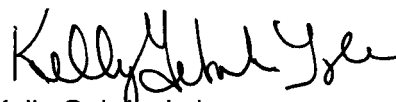
facie case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

Therefore, independent claims 1, 11 and 21 and their respective dependent claims are submitted to be allowable.

In view of all of the above, the allowance of claims 1, 4, 6-11, 14 and 16-22 is respectfully requested.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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